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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/816,941      | 04/05/2004  | Nicholas Healey      | P67148US1           | 2300             |

136 7590 06/29/2005

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| EXAMINER |
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DINH, DUC Q

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| ART UNIT | PAPER NUMBER |
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2674

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                                  |  |
|------------------------------|-------------------------------|----------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/816,941 | Applicant(s)<br>HEALEY, NICHOLAS |  |
|                              | Examiner<br>DUC Q. DINH       | Art Unit<br>2674                 |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 21-22, 35-37-38, 41-42, 46 and 50-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoggarth (U. S. Patent No. 6,654,044).

In reference to claim 21, Hoggarth discloses in Fig. 4 comprising: a post 50 (corresponding to the fixed mounting), which the lower end is rigidly secured to force transducer indicated by arrows X and Y (corresponding to the transducer means), body 62 (corresponding to the control member) connected at with the post 50 at electrical contacts within the post, the movement of the force transducer is translated into signals representing movement in the Y and X directions and the control device having a profile which is sufficiently low to enable it to be accommodated in the thickness of a base portion of the clamshell design laptop computer as indicated in the Fig. 4 (col. 4, lines 7-60).

In reference to claims 22, Hoggarth discloses the control surfaces 64 and 80 of the control member 60 as claimed.

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In reference to claims 35, Fig. 4 shows the control member is disposed in the cavity of the post 50 and the cavity having inner surface and control member 60 having outer surface facing the inner surface of the cavity and preventing the control member in the X and Y direction as claimed.

In reference to claim 36, Hoggarth discloses as the joystick is progressively rotated in several degrees of freedom, associated angular torques are generously and equiangularly resisted by the entire keyboard footprint due to the central location within the keyboard of the joystick mounting site (col. 3, lines 26-32).

In reference to claim 37, Hoggarth shows the keyboard in Fig. 1.

In reference to claim 38, Hoggarth discloses the control circuitry 12 in Fig. 4 as claimed.

In reference to claim 41, 52-54, Hoggarth discloses two switches 64 and 80 in the control member and grip-able as claimed.

In reference to claim 42, Hoggarth discloses the transducer as arrows X and Y in Fig. 4.

In reference to claims 46 and 50-51, refer to the rejection as applied to claim 1.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 29-34, 45 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoggarth.

In reference to claims 29 and 47, Hoggarth does not disclose the oval shape for the control member. However, it would be obvious to one of ordinary skill in the art to change the shape of the control member as desired as was judicially recognized with *IN RE DAILEY*, 149 USPQ 147 (CAPA 1976) which recognizes that change the form and shape of well known element is normally not desired toward patentable subject matter.

In reference to claims 30-31, 45 and 48 Hoggarth does not disclose the dimension of the control member as claimed; however, it would be obvious to one of ordinary skill in the art to change the dimension of the control member as desired as was judicially recognized with *IN ROSE* 105 USPQ 237, (CCPA 1955), which recognizes that change the size of well known element is normally not desired toward patentable subject matter.

In reference to claims 32-34, Fig. 4 shows the control member 60 is attached to the cavity of the post 50 (corresponding to the restricting member). However, Hoggarth does not disclose that the restricting member is at least 50mm or less or 30mm or less or 10 mm or less. It would have been obvious for one of ordinary skill in the art at the time of the invention was made to restrict the control member as user choice for controlling the cursor when the control member is used as a Track Point device which located in between the key of the keyboard as disclosed in Fig. 2.

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5. Claims 26-28, 39-40, 44 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoggarth in view of Klein et al. (U. S. Patent No. 6,205,021).

In reference to claim 39-40, Hoggarth discloses everything except the pointing device located in the wrist rest area of the laptop computer. Klein et al. discloses pointing device is located in the wrist rest surface of the laptop computer as claimed.

It would have been obvious for one of ordinary skill in the art at the time of the invention was made to learn the teaching of Klein et al. i.e.: providing the pointing device in the wrist rest surface so that it would not interfere with the alphanumeric key when the user using the keyboard for entering text.

In reference to claim 44, Hoggarth discloses two switches 64 and 80 in the control member as claimed.

In reference to claims 26-28 and 49, Fig. 1 of Klein et al. shows the pointing device having a wrist rest surface as claimed.

6. Claims 23-25, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoggarth in view of Gervais (U. S. Patent No. 5,508,719).

In reference to claim 23, 25 and 43, Hoggarth does not discloses the control member is a platform and the control member is disposed in a well, the well having an upper right surface and the control member having a peripheral outer surface facing inner surface and space apart therefrom defined a gap between the inner surface and the outer surface. Gervais discloses a pointing device in Fig. 3 having a platform control member and there is a gap between the inner surface of the control member and outer surface of the well.

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It would have been obvious for one of ordinary skill in the art at the time of the invention was made to learn the teaching of Gervias, i.e., modifying the control device of Hoggart for having a platform control member and there is a gap between the inner surface of the control member and outer surface of the well so that the operator can quickly move the cursor from one side of the graphics screen to the other by quickly applying a large amount of pressure to the platform.

In reference to claim 24, Hoggarth does not disclose the dimension of the control member as claimed; however, it would be obvious to one of ordinary skill in the art to change the dimension of the control member as desired as was judicially recognized with *IN Rose* 105 USPQ 237, (CCPA 1955), which recognizes that change the size of well known element is normally not desired toward patentable subject matter.

#### ***Response to Arguments***

7. Applicant's arguments, see pages 10-15, filed on February 24, 2005, with respect to the rejection(s) of claim(s) 32-35 under 112 First Paragraph have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, with respect to Art Rejection to claims 21 and 46, Applicant argues that "said the control device having a profile which is sufficient low to enable it to be accommodated in the thickness of the base portion of a clamshell design laptop computer". However, Hoggarth discloses the control post of the is low enough to be accommodated in the laptop computer as seen in Fig. 3-4. With respect to the rejections 25, see the rejections based on Hoggarth in view of Gervais above.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Hoggart

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suggested upward extension to obtain the advantage of joystick whereas the present invention teaches lateral extension in order to achieve the advantages of a mouse but without the attendant disadvantages such as the need for an appreciable area in which to move the mouse and also a connecting cable.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). With respect to the combination of

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, It would have been obvious for one of ordinary skill in the art at the time of the invention was made to learn the teaching of Klein et al. i.e.: providing the pointing device in the wrist rest surface so that it would not interfere with the alphanumeric key when the user using the keyboard for entering text.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after



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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DUC Q. DINH** whose telephone number is **(571) 272-7686**. The examiner can normally be reached on Mon-Fri from 8:00.AM-4:00.PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Edouard Patrick** can be reached on **(571)272-7603**.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**Or faxed to:**

**(703) 872-9306 (for Technology Center 2600 only)**

Hand-delivery response should be brought to: Crystal Park II, 2121 Crystal Drive,  
Arlington, Va Sixth Floor (Receptionist)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 305-4700.

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DUC Q DINH

Examiner

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DQD

June 26, 2005

  
REGINA LIANG  
PRIMARY EXAMINER